



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,764	05/04/2001	Sakae Ishikawa	207187US2	7828

22850 7590 10/14/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

BUTLER, MICHAEL E

ART UNIT	PAPER NUMBER
----------	--------------

3653

DATE MAILED: 10/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/848,764

Applicant(s)

Ishikawa et al.

Examiner

Michael E. Butler

Art Unit

3653



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 11, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above, claim(s) 12-71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

DETAILED ACTION

Priority

1. Applicant's claims of priority to Japanese applications: 2001-47288 filed 2/22/01; 2000-356640 filed 11/22/00; 2000-135235 filed 5/18/00.

Election/Restriction

2. Applicant's election of invention I without traverse in Paper No. 12 is acknowledged and made final. Applicant's election of Species I with traverse in Paper No. 12 is acknowledged and the species requirement is made final. Applicant identified claims 1-11 as reading on the elected species.

MPEP § 816 relates to patentably distinct inventions, not species.

Applicant asserts no mutually exclusive species have been identified:

Applicant per MPEP § 806.04(f), there was no identification of mutually exclusive species. Same time and different time are clearly mutually exclusive times. Same location and different locations are clearly mutually exclusive. Same type product and differing type product are mutually exclusive products.

Applicant argues there would be no undue burden to all claimed species.

However, burden is a restriction requirement element, not a species requirement element.

IDS

3. The information disclosure statement filed 5/21/01 to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 112

Art Unit: 3653

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-11 are rejected under 35 U. S. C. 112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has created an improper Markush group. Markush elements must be related. Self-propelled devices, food, substance for burning to produce heat or power would not constitute related elements. Applicant has created a language-punctuation combination appearing to create a device which predicts the pressing of a dispense request.

The applicant has conjoined elements using "and/or" creating vague and indefinite language as to the scope of the claim protection sought-alternate embodiments or a devices capable of reconfiguration for single as well as plural openings. Appropriate correction is required. The claims have been otherwise examined on the merits presuming boolean "OR."

(Re: cl 1) It is not apparent how a worksite performs delivery of an article as there is no reference to a mobile worksite.

There is no antecedent basis for rack collection center (claim 5 & 6).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Art Unit: 3653

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 1-2 and 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by

Tanaka which discloses:

(Re: cl 1) racks controlled by instruction unit 33/32 filling orders from specification unit (31; c6 L 66) management center c4 L 56-63 , second rack components for concurrent delivery with first rack components (c17 L 27-40)

(Re: cl 2) pallet with top and plurality of supports or shock absorbers 20

(Re: cl 7) third rack (c17 L 27-40)

(Re: cl 5) instruction unit includes confirmation unit; rack collection center (c10 L 58-67)

(Re: cl 6) if confirmed no stocking of second rack component at rack collection center instruction unit instructs management center to deliver rack (c11 L 1-42)

(Re: cl 8) instruction unit includes first and second instruction units (33 and 32).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Tanaka in view of Otsuka et al. wherein Tanaka discloses the elements previously

discussed and Otsuka et al. discloses:

(Re: cl 3) system sales use warehouse; rack assembled with components production site (c5 L 1-35)

(Re: cl4) instruction unit instructs management center to deliver rack (c5 L 1-35).

Art Unit: 3653

It would have been obvious at the time of the invention to move production task completed articles to storage warehouse to have them out of the way till ready for further work or shipment as taught by Otsuka et al..

10. Claims 1-2 and 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka wherein Tanaka discloses the elements previously discussed.

The examiner takes official notice that it is well known to transport computer systems together including image forming apparatus such as computer systems with printers with monitors and memory storage devices. It would have been obvious at the time of the invention to transport permutations of printers, monitors, and computer together on a rack as these components are regularly used and sold together and there common transfer would help users get the components together and come up with the instant inventions.


Art Unit: 3653

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exmr. Michael E. Butler whose telephone number is (703) 308-8344.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh, can be reached on (703) 306-4173. The fax number for the Group is (703) 305-7687.

Michael E. Butler
Examiner


DONALD P. WALSH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3000